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EXAMINER
WONG, JOSEPH D

ART UNIT	PAPER NUMBER
2166	

NOTIFICATION DATE	DELIVERY MODE
04/16/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _12 February 2009_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-15_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Response to Arguments

Specification

Objections to the specification are withdrawn.

Rejection under 35 U.S.C. §101

Rejections are withdrawn.

Rejection under 35 U.S.C. §112

Applicant's instant amendment of this claim causes the claim to be directed to what appears to be hybrid product and process combination. See MPEP 2173.05(o)(II) – heading entitled, "PRODUCT AND PROCESS IN THE SAME CLAIM". This appears ambiguous as to which statutory class it sets forth as it appears to encompass a composite rather than a statutory class in the alternative. As such, instant rejections are maintained. Appropriate clarification or correction is required.

Rejection under 35 U.S.C. §102

On page 10, paragraph 3, Applicant argues that Goodman does not teach "said data processor being further configured to compare the acquired recorded data about the transferred contents with the content IDs of said contents stored in said memory in order to determine non-

transferred contents which are established as the contents to be transferred to said external

device". However, Goodman teaches wherein said data processing block acquires recorded data

including content IDS about the contents already transferred from said information processing

apparatus to said external device connected to the apparatus (Figures 8, 10, 12, see album play

list and search retrieval queries to populate playlist), said data processing block further

comparing the acquired recorded data about the transferred contents with the content IDS of said

contents stored in said data storage block in order to determine non-transferred contents which

are established as the contents to be transferred to said external device (Fig. 8 corresponds to

display seen on Fig. 14, item 304, computer and Fig. 9 corresponds to Fig. 14, item 300, external

portable device). Note the term external is a relative term open to reasonable interpretation.

Applicant's mere argument does not specifically address how the instant claim limitations being

argued would somehow avoid the applied reference. Therefore rejections under 35 USC 102 are

stand.

On page 10, paragraph 6, there is a clerical informality in this argument that renders it

inapplicable to the instant claims being examined. Therefore rejections under 35 USC 102 are

stand.

On page 11, Applicant argues that Goodman does not teach "said data processor being

further configured to compare the acquired recorded data about the transferred contents with the

content IDs of said contents stored in said memory in order to determine non-transferred contents

which are established as the contents to be transferred to said external device" as recited in claim

1. However, Goodman teaches said data processor being further configured to compare the

acquired recorded data about the transferred contents with the content IDs of said contents stored

in said memory in order to determine non-transferred contents which are established as the

contents to be transferred to said external device in Figures 8, 10, 12, see album play list and

search retrieval queries to populate playlist with Fig. 8 to display as seen on Fig. 14, item 304,

computer and Fig. 9 corresponds to 14, item 300. Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van

Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore the prior art rejection of

claim 1 stands.

For at least the reasons above, all pending claims stand instantly rejected.

Claim Objections

Claim 14 is objected under 37 CFR 1.75 for having an unclear antecedent basis because

it recites "said information processing apparatus" without mentioning "an information processing

apparatus" initially as the term was not observed in independent claim 8. Specific correction or

clarification of the informality is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

Claim 15 is rejected for having a less than clear statutory class. The instant claim

appears directed towards a hybrid process claim because it recites a product and procedure. See

MPEP 2173.05(o)(II). Clarification is requested as to how this claim expressly or implicitly

could be a program product claim without having the formality of a tangible storage medium.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by

Goodman, (US 6,928,433 B2), hereinafter Goodman.

As to claim 1, Goodman teaches an information processing apparatus comprising: a

memory configured to store contents (Fig. 6, "the right kind of track for this branch"); and a data

processor configured to transfer said contents to an external device (Fig. 9, item 100, see portable

device and transfer from Fig. 14, items 302 to 300); wherein said processor is configured to

acquire recorded data including content IDS about the contents already transferred from said

information processing apparatus to said external device connected to said information

processing apparatus (Figures 8, 10, 12, see album play list and search retrieval queries to

populate playlist), and said processor being further configured to compare the acquired recorded

data about the transferred contents with the content IDS of said contents stored in said memory

in order to determine non-transferred contents which are established as the contents to be

transferred to said external device (Fig. 8 corresponds to display seen on Fig. 14, item 304,

computer and Fig. 9 corresponds to Fig. 14, item 300, external portable device).

As to claim 2, Goodman teaches the information processing apparatus, wherein said

processor is configured to acquire information about albums including said non-transferred

contents so that the contents held in the albums identified by the acquired information (loosely

interpreted to be optional) may be established as the contents to be transferred to said external

device (Abstract; Figures 8 and 14).

As to claim 3, Goodman teaches the information processing apparatus, wherein said data

processor is configured to cause display device to display information about albums including

said non-transferred contents and (Col. 1, Lines 35-64 "portable devices have...a compact user

interface to navigate and select among hundreds of song...can only show a few song titles at a

time"), given a selection of albums from a user in response to the displayed information (Fig. 8,

see list of tracks from "album "Meddle" displayed), to transfer the contents from the selected

albums (see "Track Name" in Fig. 8).

As to claim 4, Goodman teaches the information processing apparatus, wherein said

processor is configured to acquire information about albums having only said non-transferred

contents so that the contents held in the albums identified by the acquired information may be

established as the contents to be transferred to said external device ([7],"Favorites by Band X").

As to claim 5, Goodman teaches the information processing apparatus, wherein said data

processor is configured to cause display device to display information about albums having only

said non-transferred contents and ([62], ""Stardust does not have any entries for Album or

Artist"; Fig. 6, "no...this the right kind of track for this branch?"), given a selection of albums

from a user in response to the displayed information (Fig. 10), transfers the contents from the

selected albums (Fig. 8, see buttons on top).

As to claim 6, Goodman teaches the information processing apparatus, wherein said data

process<u>or is configured to</u> acquire recorded data about said transferred contents from said

external device (Col. 1, Lines 25-30, "MP3 and CD players both provide facilities for forming

playlists(sic)....allows selection of tracks from the PC's hard disk"), and compares the acquired

recorded data about said transferred contents with the content IDS of said contents stored in said

data storage block in order to determine non-transferred contents (Fig. 12, "Search for

Albums...BB...BEST OF BACH").

As to claim 8, Goodman teaches an information processing method for transferring

contents to an external device (Fig. 14, item 300), said information processing method

comprising the steps of: detecting said external device upon connection thereof (Fig. 14, see lines

between items 300 and 302); acquiring recorded data including content IDS about he contents

already transferred from an information processing apparatus to said external device (Col. 3,

Lines 10-12), "CDDB metadata, id3v2 metadata"; Col. 6, Line 20, "ID3 tags included in the

MP3 file" ; Col. 7, Lines 8-9, "TRACK ID"); comparing<u>, with a processor,</u> said recorded data

about the transferred contents with the content IDS of said contents stored in a <u>memory</u> of said

information processing apparatus in order to determine non-transferred contents (Col. 7, Lines

57-64, "edit the file attribute"... on the computer); and establishing said non-transferred contents

thus determined as the contents to be transferred to said external device (Col. 7, Lines 57-64,

"reinsert this track in the correct location in the tree"), before transferring said non-transferred

contents (Col. 1, Lines 25-31, "runs on a host PC and hast playlist feature that allows selection of tracks from the PC's hard disk").

As to claim 9, Goodman teaches the information processing method, further comprising the step of acquiring information about albums including said non-transferred contents so that the contents held in the albums identified by the acquired information may be established as the contents to be transferred to said external device (Col. 1, Lines 63-65, "lost songs that are not members of any playlist").

As to claim 10, Goodman teaches the information processing method, further comprising the steps of: causing <u>a display device</u> to display information about albums including said non-transferred contents (Col. 1, Lines 60-67, "lost songs that are not members of any playlist"); and given a selection of albums from a user in response to the displayed information (Fig. 10-13, see portable display), transferring the contents from the selected albums ([62], "reinsert this track").

As to claim 11, Goodman teaches the information processing method, further comprising the step of acquiring information about albums having only said non-transferred contents (Col. 1, Lines 40-65, "lost files") so that the contents held in the albums (Fig. 8) identified by the acquired information may be established as the contents to be transferred to said external device (Col. 11, Lines 28-34, "host system...is used to operate the bridge interface to transfer files").

As to claim 12, Goodman teaches the information processing method, further comprising the steps of: causing <u>a display device</u> to display information about albums having only said non-transferred contents (Col. 10, Lines 45-53, illustrates details of an item on the active queue list...when an album, song, track...is selected"); and given a selection of albums from a user in

response to the displayed information (Fig. 12-13), transferring the contents from the selected

albums (Fig. 11, see arrow points; Fig. 12, "BEST OF BACH"; Col. 2, Lines 17-29).

As to claim 13, Goodman teaches the information processing method, further comprising

the step of acquiring recorded data about said transferred contents from said external device (Fig.

8, see user interface display), before comparing the acquired recorded data about said transferred

contents with the content IDS of said contents stored in said <u>memory</u> in order to determine <u>said</u>

non-transferred contents (Col. 4, Lines 15-26).

As to claim 15, Goodman teaches a <u>computer-readable, tangible, storage medium</u>

<u>including a</u> computer program<u>, wherein the program, when executed by a computer, causes the</u>

<u>computer to execute</u> a procedure for transferring contents to an external device (Fig. 14), said

procedure comprising the steps of: detecting said external device upon connection thereof

(XXX); acquiring recorded data including content IDS about the contents already transferred

from an information processing apparatus to said external device (Fig. 7 and 13); comparing said

recorded data about the transferred contents with the content IDS of <u>the</u> contents stored in a

<u>memory</u> of said information processing apparatus in order to determine non-transferred contents

(Col. 7, Lines 45-55, "build the in-memory memory tree...add track to category..."); and

establishing said non-transferred contents thus determined as the contents to be transferred to

said external device (Fig. 14), before transferring said non-transferred contents (Col. 2, Lines 39-

50, "play back of songs from a hard disk...playbck of music from a radio receiver built into the

device...playback of voice messages").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such
> that the subject matter as a whole would have been obvious at the time the invention was made to a person having
> ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in
> which the invention was made.

Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Goodman in view of Jennery et al, (US 2003/0105847), hereinafter Jennery.

As to claim 7, Goodman teaches the information processing apparatus, wherein said data

processor is configured to store said recorded data about said transferred contents (Fig. 14,

bidirectional arrow between items 302 and 300) into a memory of said information processing

apparatus and (Fig. 14, item 300).

However, Goodman does not expressly teach based on external device identification

information acquired from said external device, to extract recorded data entries about the

transferred contents corresponding to said external device from said recorded data about said

transferred contents stored in said memory; said data processor further configured to compare

the extracted recorded data about the transferred contents with the content IDS of said contents

stored in said memory in order to determine non-transferred contents.

Jennery teaches based on external device identification information acquired from said

external device ([43], "machine ID of network device...allow different version of message

structure...to be distinguished from each other"), to extract recorded data entries about the

transferred contents corresponding to said external device from said recorded data about said

transferred contents stored in said <u>memory</u> (Fig. 5, item 64, "signature...version...id...filename";

Fig. 7); said data process<u>or</u> further <u>configured to</u> compar<u>e</u> the extracted recorded data about the

transferred contents with the content IDS of said contents stored in said <u>memory</u> in order to

determine <u>said</u> non-transferred contents ([40], "version information...date/time.../file

checksum").

Goodman and Jennery are analogous art pertinent to the problem to be solved. A skilled

artisan would have been motivated to combine Goodman and Jennery because it provides for

trigger data includes identification information for identifying the network device as discussed in

Jennery, Abstract.

Therefore at the time of invention, it would have been obvious to a person having ordinary

skill in the art to combine Goodman and Jennery because it provides for trigger data includes

identification information for identifying the network device as suggested in Jennery, Abstract.

This combination has the added advantage of facilitating network device update

instructions.

As to claim 14, Goodman teaches the information processing method according to claim,

further comprising the steps of:. (Fig. 14).

However, Goodman does not expressly teach acquiring external device identification from

said device; and based on the acquired external device identification information, extracting

recorded data entries about the transferred contents corresponding to said external device from

said recorded data about said transferred contents stored in a memory of said information

processing apparatus, before comparing the extracted recorded data about the transferred

contents with the content IDs of said contents stored in said memory in order to determine said

non-transferred contents.

Jennery teaches acquiring external device identification from said device; and based on the

acquired external device identification information ([43], "machine ID of network

device...allow different version of message structure...to be distinguished from each other"),

extracting recorded data entries about the transferred contents corresponding to said external

device from said recorded data about said transferred contents stored in a memory of said

information processing apparatus (Fig. 5, item 64, "signature...version...id...filename"; Fig. 7),

before comparing the extracted recorded data about the transferred contents with the content IDs

of said contents stored in said memory in order to determine said non-transferred contents ([40],

"version information...date/time.../file checksum").

Conclusion

Applicant's amendment necessitated the amended citations (or new ground(s)) of rejection

presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §

706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the date of this final

action.

If applicant still believes there is patentable subject matter within the disclosure and has

reasons why those differences define over the prior art, then applicant can look to

MPEP § 324 IV (September 2007) and 37 CFR 1.114 for additional suggestions that may be

helpful for overcoming the finality of this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Joseph D. Wong whose telephone number is (571) 270-1015. The

examiner can normally be reached on Monday through Friday, 10 AM – 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization

where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://portal.uspto.gov/external/portal/pair. Should you have questions on access to

the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service Representative or access to

the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-

1000.

/JDW/

Asst. Examiner, Art Unit 2166

14 April 2009.

/Srirama Channavajjala/
Primary Examiner, Art Unit 2166